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Filed : July 14, 2003

REMARKS

Applicants have canceled Claim 9 without prejudice to, or disclaimer of, the subject matter contained therein. Applicants maintain that the cancellation of a claim makes no admission as to its patentability and reserve the right to pursue the subject matter of the canceled claim in this or any other patent application.

Claim 13 is withdrawn.

Claims 8 and 10-12 are pending.

Applicants respectfully request entry of the amendments because the amendments either canceling claims or otherwise present the rejected claims in better form for consideration on appeal, in accordance with 37 C.F.R. §1.116(b). Applicants also respectfully request reconsideration of the application in view of the following remarks.

Rejections Under 35 U.S.C. §102(b)

AU 9640808A

Claims 8 and 12 are rejected under 35 U.S.C. §102(b) as being anticipated by Australian publication AU 9640808A.

The Office Action states that AU 9640808A discloses a polyester film that can be coated on both sides with an adhesive that contains pyrrolidinium rings. The Office Action states that the polyester film is transparent, and that Applicants admit that the acrylic-based adhesive and antistatic layer of AU 9640808A are transparent, and inherently maintain this transparency after one hour at 150°C. The Office Action further states that the reference's teaching of a white polyester film is only a particular embodiment of the reference, the Office Action apparently implying that other than this particular embodiment, the polyester film of AU 9640808A is transparent.

Applicants respectfully traverse.

Claim 8 recites, *inter alia*, a transparent base material film, a transparent adhesive layer formed on one side of the base material film, and a transparent antistatic layer formed on the other side of the base material film. Claim 12 is directed to the transparent surface protective film of Claim 8, where the base material film comprises polyethylene terephthalates and/or polyethylene naphthalates.

A complete reading of AU 9640808A confirms that all embodiments provided therein lack transparency, and therefore, the whole of AU 9640808A is distinct from Applicants' claims. As such, AU 9640808A cannot anticipate Claim 8 or any claim dependent therefrom.

At page 11, lines 12-14, the reference teaches:

The adhesive polyester film of the present invention has at least one of a magnetic recording layer and a printing ink layer formed on the adhesive coating film.

The reference provides various configurations of the magnetic recording layers and/or printing ink layers at page 11, lines 15-31. Examples of the compositions used to make up the magnetic recording layers are provided at page 11, line 33, through page 12, line 5, and page 6, line 9. Examples of the compositions used for printing ink are provided at page 12, lines 6-9. None of these examples are transparent. Thus, AU 9640808A teaches that the polyester film has at least a non-transparent magnetic recording layer or a non-transparent printing ink layer. As such, the reference clearly teaches that, without exception, the disclosed adhesive polyester film always has a layer that is not transparent. Therefore, the polyester film of AU 9640808A cannot anticipate the claimed transparent surface protective film.

Moreover, all of the Examples and Comparative Examples have polyesters comprising 10% by weight of titanium oxide, and all of the Examples and Comparative Examples have polyester films containing both ink and a magnetic coating (except Comparative Examples 2 and 3 which were too unstable to be prepared). Accordingly, every embodiment disclosed in AU 9640808A is non-transparent.

In addition, AU 9640808A addresses only pigment-containing polyesters, and never mentions that the polyester can be transparent. For example, at page 1, lines 7-10 the reference discusses, "Aromatic polyester films, particularly aromatic polyester films containing white pigment such as titanium oxide, are used in a wide variety of fields such as magnetic cards, printing materials and the like." At page 4, lines 4-5, the reference teaches "In the present invention, the aromatic polyester preferably contain [sic] white pigment." Apparently, the Office Action interprets this as a teaching that non-preferred embodiments are transparent. However, there is a complete absence of any teaching that any embodiment of the polyester used in AU 9640808A would be transparent. Moreover, even if a polyester of AU 9640808A were to be transparent, the polyester film of AU 9640808A nevertheless contains either a non-transparent

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magnetic recording layer or a non-transparent printing ink layer, or both, rendering the polyester film itself non-transparent.

In conclusion, AU 9640808A discloses that the polyester film contains at least one non-transparent layer, and AU 9640808A does not disclose that any component of the disclosed polyester film is transparent. The polyester film contains a preferably white pigment, and always contains either a non-transparent printing ink layer, a non-transparent magnetic coating, or both. As such, AU 9640808A discloses that the polyester film is always non-transparent.

Furthermore, Applicants' specification does not refer to AU 9640808A, and makes no comment about any component of the transparent surface protective film that is necessarily identical to those used in AU 9640808A. Accordingly, Applicants' specification makes no admission as to the opaqueness or transparency of any component of the polyester film of AU 9640808A.

In view of the above, Applicants submit that Claims 8 and 12 are novel over the film of AU 9640808A, and respectfully request removal of this ground for rejecting Claims 8 and 12.

Malhotra

Claims 8 and 12 are rejected under 35 U.S.C. §102(b) as being anticipated by the Malhotra (U.S. Pat. No. 5,534,374).

The Office Action states that Malhotra discloses a transparent polyester substrate. The Office action also states that the adhesive of Malhotra can be acrylic-based, which is known to be transparent as admitted at page 8 Applicants' specification, the antistatic layer of Malhotra comprises an antistatic agent, such as pyrrolidine acid salt compounds and would be inherently transparent as admitted at page 12 in Applicants' specification. The Office Action further states that the laminate will inherently exhibit the maintaining of the transparency under the conditions recited in Claim 8.

Applicants respectfully traverse.

Malhotra does not disclose an antistatic layer comprising polymers having pyrrolidinium rings in their main chains. Specifically, Malhotra discloses:

The antistatic layer generally comprises a binder and an antistatic agent.
Malhotra, at column 16, lines 44-45.

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Any suitable or desired binder can be employed. Examples of suitable binders include ... [listing of various binders]. *Malhotra*, at column 16, lines 65-66; listing of binders spanning column 16, line 66, through column 21, line 12.

Any desired or suitable antistatic agent can be employed. Examples of suitable antistatic agents include amine acid salts and quaternary choline halides. [listing of various antistatic agents]. *Malhotra*, at column 21, lines 15-17; listing of binders spanning column 21, line 16, through column 62, line 67.

Also suitable as antistatic agents are pyrrole and pyrrolidine acid salt compounds ... [listing of various pyrrole and pyrrolidine acid salt antistatic agents]. *Malhotra*, at column 30, line 21; listing of pyrrole and pyrrolidine acid salt antistatic agents spanning column 30, line 21, through column 31, line 65.

Although *Malhotra* provides exhaustive lists of possible binders and antistatic agents, *Malhotra* provides no information regarding any particular relationship between the binders and the antistatic agents. In particular, nothing in *Malhotra* would suggest that any of the antistatic agents are incorporated in the main chains of polymers. More particularly, *Malhotra* discloses antistatic agents that are pyrrole and pyrrolidine acid salt compounds, but does not disclose such compounds incorporated into the main chains of polymers in the antistatic layer. *Malhotra* is silent regarding an antistatic layer comprising polymers having pyrrolidinium rings in their main chains.

Applicants have previously pointed out that *Malhotra* does not disclose an antistatic layer comprising polymers having pyrrolidinium rings in their main chains. In response, the Office Action states that Applicants' argument "fails to provide any explanation to said effect." *Office Action* at page 5. Applicants submit that it is difficult to point out with particularity that which is absent (*i.e.*, any disclosure of an antistatic layer comprising polymers having pyrrolidinium rings in their main chains). Nevertheless, Applicants have provided herein above an identification of portions of *Malhotra* in which such disclosure would have been included, had *Malhotra* provided such disclosure. However, *Malhotra* is completely silent regarding an antistatic layer comprising polymers having pyrrolidinium rings in their main chains.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki*

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Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The Office Action makes no assertion that Malhotra discloses an antistatic layer comprising polymers having pyrrolidinium rings in their main chains. The Office Action points to no portion of Malhotra that discloses an antistatic layer comprising polymers having pyrrolidinium rings in their main chains. Accordingly, the Office Action provides no basis to conclude that Malhotra discloses all elements of the claims. Moreover, as discussed above, Malhotra is completely silent regarding an antistatic layer comprising polymers having pyrrolidinium rings in their main chains. Therefore, it is not possible to identify portions in Malhotra in which "each and every element as set forth in the claim is found." As such, because Malhotra does not teach all elements of Claim 8, Malhotra does not anticipate Claim 8 or any claim dependent therefrom.

In view of the above, Applicants submit that Claim 8 is novel over the film of Malhotra, and respectfully request removal of this ground for rejecting Claims 8 and 12.

Claim 12

Claim 12 is even further novel over Malhotra because Malhotra does not disclose a base material film that comprises polyethylene terephthalates and/or polyethylene naphthalates. Malhotra does not disclose a single terephthalate or naphthalate. Malhotra does not even disclose polyethylene. Again, Applicants submit that it is difficult to point out with particularity that which is absent (*i.e.*, any disclosure of polyethylene terephthalates and/or polyethylene naphthalates). Nevertheless, the terms "terephthalate," "naphthalate," and "polyethylene" simply do not exist in any location of Malhotra. Therefore, Malhotra does not teach all elements of Claim 12, and, accordingly Malhotra does not anticipate Claim 12.

Rejection Under 35 U.S.C. §103

Claims 10 and 11 are rejected under 35 U.S.C. §103 as being anticipated by AU 9640808A or Malhotra.

The Office Action states that it would have been obvious to optimize the adhesive thickness through routine experimentation.

Applicants respectfully traverse.

Claims 10 and 11 depend from Claim 8 and further recite that the thickness of said adhesive layer is about 3-100 μm , and about 5-40 μm , respectively.

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Claims 10 and 11 are non-obvious over the cited references for at least the reasons presented in regard to Claims 8 and 12 above. Specifically, nothing in AU 9640808A would have motivated one of ordinary skill in the art to develop a transparent surface protective film in accordance with Claim 8 because AU 9640808A teaches the desirability of a polyester to contain a white pigment, and the necessity of the polyester film to contain a non-transparent ink layer and/or a non-transparent magnetic recording layer. Further, AU 9640808A teaches that such a polyester film is "useful as a printing material and a material for use in magnetic cards and magnetic disks." AU 9640808A at page 20, lines 2-6. Thus, removing the ink and magnetic layers would render the polyester film of AU 9640808A unsatisfactory for its intended purpose. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Accordingly, it would not have been obvious to modify the reference to arrive at the transparent surface protective film of Claim 8, from which Claims 10 and 11 depend.

Even if it would have been obvious to modify AU 9640808A to arrive at the transparent surface protective film of Claim 8, AU 9640808A teaches away from a modification of the polyester film of AU 9640808A to arrive at the surface protective film of Claim 10 or Claim 11. Regarding the antistatic adhesive layer, AU 9640808A teaches:

The thickness of the final dried coating film needs to be 0.01 to 1 μm , preferably 0.02 to 0.6 μm . If the thickens [sic] is less than 0.01 μm , sufficient antistatic properties cannot be obtained and if the thickness is more than 1 μm , lubricity deteriorates unfavorably. AU 9640808A at page 10, lines 22-27 (emphasis added).

Thus, AU 9640808A teaches that modification of the adhesive layer of AU 9640808A to the thicknesses recited in Claims 10 and 11 would result in unfavorable deterioration of lubricity according to AU 9640808A. As such, AU 9640808A teaches away from the thicknesses of the adhesive layer recited Claims 10 and 11. A *prima facie* case of obviousness can be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). Since AU 9640808A teaches that modification of the adhesive layer of AU 9640808A to the thicknesses recited in Claims 10 and 11 would result in unfavorable deterioration of lubricity according to AU 9640808A,

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such a modification of the adhesive layer of AU 9640808A would not have been an obvious optimization of AU 9640808A. Accordingly, one skilled in the art would not have been motivated to modify the teachings of AU 9640808A to arrive at the surface protective film of Claims 10 or 11. As such, the surface protective films of Claim 10 and Claim 11 are not obvious over the teachings of AU 9640808A.

Claims 10 and 11 also are non-obvious over Malhotra for at least the reasons presented in regard to Claims 8. Specifically, nothing in Malhotra would have motivated one of ordinary skill in the art to develop a transparent surface protective film in accordance with Claim 8 because Malhotra does not teach or suggest the desirability of an antistatic layer comprising polymers having pyrrolidinium rings in their main chains. Obviousness can only be established by modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). Malhotra provides no teaching, suggestion, or motivation to form an antistatic layer by doing anything other than combining a binder and an antistatic agent. See Malhotra, at column 16, lines 44-45. In particular, nothing in Malhotra would have motivated one of ordinary skill in the art to form an antistatic layer comprising polymers having pyrrolidinium rings in their main chains. Accordingly, it would not have been obvious to modify the reference to arrive at the transparent surface protective film of Claim 8, from which Claims 10 and 11 depend.

Even if it would have been obvious to modify Malhotra to arrive at the transparent surface protective film of Claim 8, Malhotra teaches away from a modification of the migration imaging member of Malhotra to arrive at the surface protective film of Claim 10 or Claim 11. Regarding the antistatic adhesive layer, Malhotra teaches:

When an adhesive layer is employed, it preferably forms a uniform and continuous layer having a thickness of about 0.5 micron or less to ensure satisfactory discharge during the imaging process. *Malhotra* at column 12, lines 59-62.

Thus, Malhotra teaches that an adhesive layer such as that recited in Claims 10 or 11 would not be desirable because it would not be capable of ensuring satisfactory discharge during the imaging process. Accordingly, Malhotra teaches away from the thicknesses of the adhesive layer recited Claims 10 and 11. Since such a modification of Malhotra would result in unfavorable

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properties according to Malhotra, modification of the migration imaging member of Malhotra to the thicknesses recited in Claims 10 and 11 would not have been an obvious optimization of Malhotra. Accordingly, one skilled in the art would not have been motivated to modify the teachings of Malhotra to arrive at the surface protective film of Claims 10 or 11. As such, the surface protective films of Claim 10 and Claim 11 are not obvious over the teachings of Malhotra.

Rejection Under 35 U.S.C. §112

Claim 9 is rejected under 35 U.S.C. §112 as failing to comply with the written description requirement.

Claim 9 is canceled herein. Accordingly, this rejection is moot.

CONCLUSION

In light of the Applicants' amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

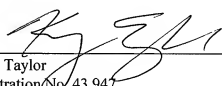
Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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